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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,345	08/09/2000	Albert K. Chin	AKC-22900 [R0171]	5920
7590 06/16/2004			EXAMINER	
ALBERT C. SMITH FENWICK & WEST LLP 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			BARRETT, THOMAS C	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/635,345

Applicant(s)

CHIN, ALBERT K.

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-37 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 12, 13, 15-22 and 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 23-27 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/3/03-12/29/03</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-7, 11, 23-27, and 34-37 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (5,033,477) in view of Chin et al. (WO 97/23861). Chin '477 discloses a method of performing a cardiac procedure through a subxiphoid incision and gripping a flap of the pericardium using an instrument and cutting said flap of the pericardium while spaced away from the underlying heart (Fig. 7) however fails to disclose the procedure under endoscopic visualization. Chin et al. '861 teaches the use of a rigid endoscopic cannula having a transparent tip (Fig. 1), which allows atraumatic dissection of a cavity with sufficient control and maneuverability (page 6, lines 29-31). It would have been obvious to one of ordinary skill in the art to combine the teaching of a rigid endoscopic cannula having a transparent tip, as taught by Chin et al. '861, to disclose a method of performing a cardiac procedure through a subxiphoid incision as per Chin '477, in order to allow atraumatic dissection of a cavity with sufficient control and maneuverability.

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Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (5,033,477) in view of Chin et al. (WO 97/23861) as above, in further view of P.J. de Feyter et al. (Permanent Cardiac Pacing...) as disclosed in Applicant's IDS. Chin '477 discloses a method of performing a cardiac procedure using an endoscopic cannula however Chin '477 fails to disclose a second subxiphoid incision. P.J. de Feyter et al. teaches a surgical method comprising a second subxiphoid incision for holding the pacemaker generator (page 145, 2<sup>nd</sup> column). It would have been obvious to one of ordinary skill in the art to combine the teaching of a surgical method comprising a second subxiphoid incision, as taught by P.J. de Feyter et al., to a method of performing a cardiac procedure using an endoscopic cannula as per Chin '477, for creating a pocket for holding the pace-maker generator.

Claims 11 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (5,033,477) in view of Chin et al. (WO 97/23861) as above, in further view of Vaska et al. (6,237,605 B1). Chin '477 discloses a method of performing a cardiac procedure using an endoscopic cannula however Chin '477 fails to disclose using the cannula for a cardiac mapping procedure. Vaska et al. teaches the mapping of the conduction pathways of the heart for the diagnosis of electrophysiological disorders (Figs. 8 and 9). It would have been obvious to one of ordinary skill in the art to combine the teaching of the mapping of the conduction pathways of the heart, as taught by Vaska et al., to a method of performing a cardiac procedure using an endoscopic cannula as per Chin '477, in order to for the diagnosis of electrophysiological disorders.

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Please Note: The process of cardiac mapping inherently involves a sweeping motion of the device over the anterior and posterior of the heart.

Claims 6 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (5,033,477) in view of Chin et al. (WO 97/23861) as above, in further view of Hildwein et al. (5,391,156). Chin '477 discloses a method of performing a cardiac procedure using an endoscopic cannula however Chin '477 fails to disclose laterally expanding a sheath responsive to passing the endoscopic cannula. Hildwein et al. teaches a laterally expanding sheath (Figs. 16A-B) which provides a relatively wide range of angular displacement (col. 8, lines 6-9). It would have been obvious to one of ordinary skill in the art to combine the teaching of a laterally expanding sheath, as taught by Hildwein et al., to a method of performing a cardiac procedure using an endoscopic cannula as per Chin '477, in order to provide a relatively wide range of angular displacement. Please Note: The passing of tools through the flexible sheath of Hildwein et al. inherently dilates adjoining tissue.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas Barrett



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